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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/590,592	06/08/2000	David S. Jones	252312007300	1002
25226	7590	06/16/2005	EXAMINER	
MORRISON & FOERSTER LLP 755 PAGE MILL RD PALO ALTO, CA 94304-1018			LUKTON, DAVID	
			ART UNIT	PAPER NUMBER
			1653	
DATE MAILED: 06/16/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/590,592

Applicant(s)

JONES ET AL.

Examiner

David Lukton

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 66-71, 131-135, 141-143, 147, 151-153, 159 and 160 is/are allowed.
- 6) ☒ Claim(s) 82, 124, 148, 150, 170 and 171 is/are rejected.
- 7) ☒ Claim(s) See Continuation Sheet is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims pending in the application are 38,46,54-57,66-71,82-87,89-93,108-110,119,124,126-128 and 131-174.

Continuation of Disposition of Claims: Claims objected to are 38,46,54-57,83-87,89-93,108-110,119,126-128,136-140,144-146,149,154-158,161-169 and 172-174.

Pursuant to the directives of the amendment filed 3/10/05, claims 38, 67, 83, 89-91, 110, 131-133, 137, 166 and 169 have been amended. Claims 38, 46, 54-57, 66-71, 82-87, 89-93, 108-110, 119, 124, 126-128, 131-174 remain pending.

Applicants' arguments filed 3/10/05 have been considered and found persuasive in part. Claims 82, 124, 148, 150, 170, 171 are rejected under 35 U.S.C. §112 second paragraph, claim 46 is objected to because of a spelling error. The following claims are objected to because each is dependent on a claim that has been rejected or objected to: 38, 46, 54-57, 83-87, 89-93, 108-110, 119, 126-128, 136-140, 144-146, 149, 154-158, 161-169, 172-174.



Claim 46 is objected to. The term "moiety" is misspelled.



Claims 82, 124, 148, 150, 170, 171 are rejected under 35 U.S.C. §112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 82 recites that "n is about 200 to about 500". However, this renders the claim indefinite as to the upper and lower limits of the range.
- Claim 124 recites the phrase "less than about 1.2", thus rendering the claim indefinite as to the upper limit.
- Claim 148 recites the phrase "less than about", thus rendering the claim indefinite as to

the upper limit of polydispersity. See also claim 150.

- Claim 170 recites the phrase “between about 1.05 to 1.2”. However, this renders the claim indefinite as to the upper and lower limits of the polydispersity. The same issue applies in the case of claim 171.

The remaining issue is thus the indefiniteness generated by the presence of the term “about” in reference to a range. Applicants have begun by arguing that the USPTO previously allowed the claims and now they are rejecting them. Reference to the “USPTO” in this way implies applicants’ view that the agency in question is a monolithic entity. However, this is not necessarily the case. Next, applicants have argued that the examiner has provided no reason why the term “about”, in reference to a range, renders a claim indefinite. This particular assertion is untrue. Next, applicants have implied that section 706.04 of the MPEP prohibits rejection of a previously allowed claim. However, this is not true. This section of the MPEP deals primarily with prior art rejections, which is not relevant to the issue here. As for making a 112, second paragraph rejection against previously allowed claims, the MPEP urges only that “great care” be undertaken before imposing such a rejection. As it happens, this particular exhortation has been adhered to.

Next, applicants have suggested that the term “about”, when used in a claim which does not recite a range, does not render the claim indefinite. While this may be true, it is not the issue here. Instead, the issue is the indefiniteness of the term “about” when used in reference to a

range. Applicants have also argued that the MPEP sanctions use of the term “about” in the following phrase: “between 25 to about 45% of the mold entrance”. However, the panel of judges in *Amgen, Inc. v. Chugai Pharmaceutical Co.*, (927 F.2d 1200, 18 USPQ2d 1016 (Fed. Cir. 1991)) held that claims reciting “at least about” were invalid for indefiniteness. Accordingly, there is no universal view that the “immunity” implied by applicants does or should exist. Consider, for example, claim 170 which recites the phrase “between about 1.05 to 1.5”. What is included, and what is excluded? Is a polydispersity of 0.8 included? What about a polydispersity of 0.3...?

Next, applicants have argued that more than 700,000 patents have issued in which claims reciting the term “about” are present. This figure is not in dispute, but in a significant portion of the claims in those 700,000 patents, the term “about” is not being used in conjunction with a range. Nevertheless, the examiner readily concedes that the standards with regard to the imposition of 112, second paragraph are not consistent, at least with regard to the presence of the term “about” in reference to a range. However, inconsistent enforcement of laws is the norm throughout society. If a person has been charged with violation of a civil code, it is generally considered to be an inadequate defense for the accused to argue that police and prosecutors have abstained from enforcing the law when others have committed similar violations. For example, a person charged with driving 75 mph in a 55 mph zone is unlikely to be acquitted of the charge merely because thousands of other drivers travel at that speed and

are not charged with a violation. Thus, the fact that other examiners have abstained from imposing a 112, 2nd paragraph rejection when a claim recites the term “about” in reference to a range does not, in and of itself, mean that the rejection is improper when a given examiner decides to impose the rejection.

Next, applicants have argued that the primary examiner (Jon Weber) who is advocating the rejection at issue has abstained from imposing the rejection in each of four applications, i.e., those resulting in the following patents: ‘711, ‘299, ‘431 and ‘752. In the first three of these, a final rejection was issued before examiner Weber had the opportunity to review the case. In the application resulting in USP ‘752, the application was allowed in July of 2004. Thus, applicants are correct that in July of 2004 there was at least one case where the primary examiner in question abstained from requiring a §112, 2nd paragraph rejection. However, this rejection is now imposed in June of 2005. The action taken by the primary examiner 11 months earlier in another application is not binding in the instant case. Applicants have also argued that because there are examples of examiners who have abstained from imposing a 112, second paragraph rejection when the term “about” is used in reference to a range, it is justified to conclude that (a) “the Patent Office” is a monolithic entity, and (b) that monolithic entity has concluded that when the term “about” is used in reference to a range, the claim is not rendered indefinite thereby. However, applicants are not correct. The fact that some examiners have abstained from imposing a 112, second paragraph rejection in such a situation does not

mean that all others have abstained. Merely looking at claims of issued patents may provide some insight into the rejections that have not been imposed, but provides no insight into the rejections that have been imposed. Thus, applicants' analysis is far from complete.

The rejection is maintained.



THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED AND ANY EXTENSION FEE PURSUANT TO 37 CFR 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is 571-272-0952. The examiner can normally be reached Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber, can be reached at 571-272-0925. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.



DAVID LUKTON
PATENT EXAMINER
GROUP 1800